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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,176	03/23/2006	Wolfgang Staehle	MERCK3155	6633

23599 7590 12/27/2010
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EXAMINER

OTTON, ALICIA L

ART UNIT	PAPER NUMBER
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1626

NOTIFICATION DATE	DELIVERY MODE
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12/27/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/573,176	Applicant(s) STAEHLE ET AL.	
	Examiner Alicia L. Otton	Art Unit 1626	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 December 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: 7 and 8.
 Claim(s) rejected: 1,3,5,9-11 and 30-38.
 Claim(s) withdrawn from consideration: 6 and 14-29.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☒ Other: See Continuation Sheet.

/YONG CHU/
 Primary Examiner, Art Unit 1626

Continuation of 3. NOTE: Although the amendment narrows the scope of the pending claims by deleting the option for R3=H, the amendments would raise new issues that would require further consideration because they would necessitate further expanding the search of the compound claims past that which has already been considered and examined. Since prosecution on the merits has been closed, no amendment can be entered which would necessitate a new search of a portion of the claimed scope which has not yet been considered (i.e. variables appearing in the claims which have not yet been searched).

Continuation of 11. does NOT place the application in condition for allowance because: Firstly, it is noted that Applicants request withdrawal of finality of the previous Office action. Applicants arguments have been considered but are not found to be persuasive. All prior art rejections from the non-final Office action mailed on 4/12/10 were properly maintained in the final rejection. As such, the Office action could have been properly made final if just these rejections were presented in the final Office action. Applicants state that the presence of this compound was clearly a typographical error since the claim does not state that the compound is being claimed. The Examiner respectfully disagrees. Each claim must be examined for any limitations recited in the claim. Even if the inclusion of the compound 477 was a typographical error, it was still a limitation that is required to be considered in the Examination of the claim. All previously made prior art rejections were properly maintained.

It is further noted that additional art was presented in order to attempt to expedite prosecution more quickly. Applicants state that the application of this new art was not necessitated by amendment. However, in the non final office action of 4/12/10, it was clearly stated that claims 2, 8 and 38 were objected to but that the subject matter was not necessarily allowable; since the claims were examined under 803.02 practice, the search had not yet been extended to include those specific limitations as of the 4/12/10 office action. MPEP 803.02 clearly states that if Applicants amend or narrow the limitations to overcome art applied to the scope which has been searched or examined in a non-final office action, the examiner can extend the scope of the searched subject matter to a species chosen by the examiner, apply the new art and go final.

Continuation of 13. Other: It is noted that a petition to withdraw the restriction requirement was filed with the response on 12/9/10. However, as of the mailing of this Office action, the petition has not yet been reviewed by the appropriate party. Due to time constraints, this Office action had to be mailed before said petition could be considered, but if the decision in the petition warrants another action, appropriate action will be taken at that time.